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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/499,553	02/07/2000	Louis Paul Deiss	65507-B/JPW/FHB	1435

7590

05/07/2003

John P. White
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New York, NY 10036

EXAMINER

BRUSCA, JOHN S

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 05/07/2003

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/499,553

Applicant(s)

DEISS ET AL.

Examiner

John S. Brusca

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the corresp ndence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-35 is/are rejected.
- 7) ☒ Claim(s) 36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 February 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8,15.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1631

DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

The specification to which the oath or declaration is directed has not been adequately identified. See MPEP § 601.01(a).

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on International application PCT/US97/20989 filed on 12 November 1997. It is noted, however, that applicant has not filed a certified copy of the International application as required by 35 U.S.C. 119(b).

Specification

3. The disclosure is objected to because of the following informalities: Tables 1 and 2 on pages 45-51 are redundant to the Sequence Listing and should be deleted.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 34 recites the limitation "the identified antisense expression vectors" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 28-35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,057,111. Although

Art Unit: 1631

the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-7 of U.S. Patent No. 6,057,111 are drawn to a species of instant claims 28-35 in which the selection is a positive selection.

Allowable Subject Matter

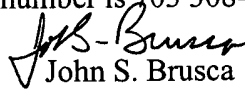
8. Claim 36 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Brusca whose telephone number is 703 308-4231. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 703 308-4025. The fax phone numbers for the organization where this application or proceeding is assigned are 703 746-5137 for regular communications and 703 746-5137 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0196.


John S. Brusca
Primary Examiner
Art Unit 1631

jsb
May 5, 2003

PTO/SB/67 (08-03)

Approved for use through 07/31/2008. OMB 0651-0031
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POWER TO INSPECT/COPY		Docket Number (Optional) 2094/65507-B
<p>In re Application of Louis Paul Deiss et al.</p> <p>Application Number 09/499,553 Filed 02/07/00</p> <p>Art Unit 1631 Examiner J. Brusca</p>		<p>Paper No. _____</p>
<p>Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450</p> <p>Please permit the following person(s) to inspect and make copies of the above identified application:</p> <p><u>Ms. Helene Stanonick</u></p> <p>_____</p> <p>_____</p>		
<p>I am an:</p> <p><input type="checkbox"/> Applicant.</p> <p><input type="checkbox"/> Authorized official of the assignee of record. The assignment was recorded in the United States Patent and Trademark office at Reel _____ Frame _____ or for which a copy thereof is attached.</p> <p><input checked="" type="checkbox"/> Attorney or agent of record. Registration No. <u>28,678</u></p> <p><input type="checkbox"/> Attorney or agent named in the application papers filed under 37 CFR 1.53, 1.494, or 1.495 (37 CFR 1.63 or 1.497 oath or declaration not filed). Registration No. _____</p>		
<p>Signature _____</p> <p><u>John P. White</u></p> <p>Typed or printed name _____</p> <p><i>[Signature]</i></p> <p>Title (Officer of company or corporate assignee) _____</p> <p><u>Quark Biotech, Inc.</u></p> <p>Name of Assignee, if any (e.g., company name) _____</p> <p><u>(212) 278-0400</u></p> <p>Telephone Number _____</p>		<p style="text-align: center;">August 13, 2003</p> <p style="text-align: center;">Date</p> <p style="writing-mode: vertical-rl; transform: rotate(180deg);">03 SEP 30 PM 4:24</p>
		<p style="text-align: center;">FOR PTO USE ONLY</p> <p>Approved by: _____ (initials)</p> <p>Unit: _____</p>

This collection of information is required by 37 CFR 1.14. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.